

**To:** Razer (Asia-Pacific) Pte Ltd ([anye@lawyersatlargellc.com](mailto:anye@lawyersatlargellc.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 79106761 - MOUSE BUNGEE - N/A  
**Sent:** 9/10/2013 1:25:03 PM  
**Sent As:** ECOM102@USPTO.GOV  
**Attachments:**

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)**

**OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

**U.S. APPLICATION SERIAL NO.** 79106761

**MARK:** MOUSE BUNGEE

**\*79106761\***

**CORRESPONDENT ADDRESS:**

AMANDA LAURA NYE

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**CLICK HERE TO RESPOND TO**

<http://www.uspto.gov/trademarks/teas/r>

**APPLICANT:** Razer (Asia-Pacific) Pte Ltd

**CORRESPONDENT'S REFERENCE/DOCKET NO :**

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

[anye@lawyersatlargellc.com](mailto:anye@lawyersatlargellc.com)

**OFFICE ACTION**

**STRICT DEADLINE TO RESPOND TO THIS LETTER**

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

**ISSUE/MAILING DATE: 9/10/2013**

**THIS IS A FINAL ACTION.**

**INTERNATIONAL REGISTRATION NO. 1100667**

This Office action is in response to applicant's response filed on 08/15/2013. In the response, applicant re-submitted a claim of acquired distinctiveness based on new dates of use in commerce supported by an affidavit from a company executive in order to obviate the descriptiveness refusal under Trademark Act Section 2(e)(1).

The refusal under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), is now made FINAL for the reasons set forth below. 37 C.F.R. §2.64(a).

**FINAL: Claim of Acquired Distinctiveness is Not Accepted**

The descriptiveness refusal under Trademark Act Section 2(e)(1) is made FINAL because applicant's continued claim of acquired distinctiveness is not accepted, and there are no other new issues raised for examination.

**Procedural History**

Applicant was advised in the first Office action of 03/05/2012 and the Final Office action of 08/22/2012 that it may amend the application to seek registration on the Principal Register pursuant to Trademark Act Section 2(f) if applicant has used its mark for a significant period of time in commerce that may lawfully be regulated by the United States Congress. See 15 U.S.C. §§1052(f), 1127; *In re Etablissements Darty et Fils*, 759 F.2d 15, 18, 225 USPQ 652, 654 (Fed. Cir. 1985); TMEP §1212.08. This use in commerce must be substantially exclusive and continuous for at least the five years prior to the date the amendment to Section 2(f) is requested. 15 U.S.C. §1052(f); TMEP §1212.05.

In the second request for reconsideration filed with an appeal to the Trademark Trial and Appeal Board on 02/22/2013, applicant claimed acquired distinctiveness under Trademark Act Section 2(f) based on evidence. The evidence consisted of the following claims;

(1) An affidavit from the applicant that mark has become distinctive "of the relevant services through Applicant's substantially exclusive and continuous use in commerce for at least the three years immediately preceding the date of this statement."

(2) Applicant's statement from Ong Chin Gee, IP Executive, that as "as early as 2010" applicant has continuously and exclusively used the mark for the class 009 goods, that "I believe that the mark has become distinctive of these goods based on such use."

(3) Applicant continues to use the mark in commerce with the goods.

**The examining attorney determined the 02//22/2013 claim of acquired distinctiveness was not persuasive or accepted because:**

(1) Applicant had not demonstrated or submitted any actual evidence to show that applicant has used its mark for a significant period of time in commerce that may lawfully be regulated by the United States Congress. See 15 U.S.C. §§1052(f), 1127; *In re Etablissements Darty et Fils*, 759 F.2d 15, 18, 225 USPQ 652, 654 (Fed. Cir. 1985); TMEP §1212.08.

(2) The date of use of the mark since 2010 had not been used in commerce regulated by the United States Congress for at least 5 years prior to the date of the claim.

(3) Statements from applicants' IP Executive were deemed insufficient without a factual basis for the declarant's belief that the mark has become distinctive for the goods in the minds of U.S. consumers.

Accordingly, acquired distinctiveness claim under Trademark Act Section 2(f) was rejected, and the refusal under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1) was appropriately maintained and continued.

In the applicant's 08/15/2013 response to the rejection of the acquired distinctiveness claim under Trademark Act Section 2(f) and the maintained descriptiveness refusal under Trademark Act Section 2(e)(1), applicant (1) re-asserted the 2(f) claim based amended on an amended date of use in commerce on use in commerce since 1998, and (2) submitted a new declaration from the applicants' IP Executive that changed the claim of use in commerce since 1998.

**Additional Evidence of Acquired Distinctiveness Required for Highly Descriptive Marks**

Applicant has asserted acquired distinctiveness based on the evidence of record; however, such evidence is not sufficient to show acquired distinctiveness because, as demonstrated by the previously attached evidence, because applicant's mark is of a highly descriptive nature. *See* Trademark Act Sections 2(e)(1) and 2(f), 15 U.S.C. §1052(e)(1), (f); *In re MetPath, Inc.*, 1 USPQ2d 1750 (TTAB 1986); TMEP §1212.04(a). **Additional evidence is needed.**

When asserting a Trademark Act Section 2(f) claim, the burden of proving that a mark has acquired distinctiveness is on the applicant. *Yamaha Int'l Corp. v. Yoshino Gakki Co.*, 840 F.2d 1572, 1578-79, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988); *In re Meyer & Wenthe, Inc.*, 267 F.2d 945, 948, 122 USPQ 372, 375 (C.C.P.A. 1959); TMEP §1212.01. **Thus, applicant must establish that the purchasing public has come to view the proposed mark as an indicator of origin.**

In the present case, applicant's evidence consists of the following:

(1) Statements from applicant's IP Executive claiming acquired distinctiveness based on use the mark in commerce since 1998.

(2) Applicant's supports the claim of use since 1998 by stating its' claim of first use "is by Confirmatory Assignment assigning all right title and interest to the predecessor- in-interest to Applicant." Applicant claims the assignment was recorded with the USPTO.

Applicant's claim of acquired distinctiveness based on use since 1998 in commerce is insufficient to show acquired distinctiveness of the mark because applicant's mark, MOUSE BUNGEE, combines a highly descriptive term for the use of BUNGEE, i.e., a MOUSE, with a generic term for the goods, i.e., a bungee.

First, the examining attorney maintains that applicant's own statements regarding its belief about acquired distinctiveness are not persuasive because applicant has a vested interest in the statement being accepted, and it does not establish that the mark has acquired distinctiveness in the minds of consumers. Affidavits or declarations that assert recognition of the mark as a source indicator are relevant in establishing acquired distinctiveness. However, the value of the affidavits or declarations depends on the statements made and the identity of the affiant or declarant. See *In re Chem. Dynamics Inc.*, 839 F.2d 1569, 1571, 5 USPQ2d 1828, 1830 (Fed. Cir. 1988) (finding conclusionary declaration from applicant's vice-president insufficient without the factual basis for the declarant's belief that the design had become distinctive). See TMEP §1212.06(c). Similarly here, applicant's statements regarding long use of the mark in commerce since 1998 are insufficient without a further factual basis for the declarant's belief that the mark has become distinctive for the goods in the minds of U.S. consumers since the mark is so highly descriptive.

Second, the evidentiary value, effect and factual basis of the claimed "Confirmatory Assignment" are vague, unclear and undocumented. There are no records of an assignment of this application with the Assignment Services division as the Trademark Office, or even any claim of ownership of any prior U.S. Registrations. Therefore, these statements are not persuasive on the issue of acquired distinctiveness and do not raise a new issue for examination.

When asserting a Trademark Act Section 2(f) claim, the burden of proving that a mark has acquired distinctiveness is on the applicant. *Yamaha Int'l Corp. v. Yoshino Gakki Co.*, 840 F.2d 1572, 1578-79, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988); *In re Meyer & Wenhe, Inc.*, 267 F.2d 945, 948, 122 USPQ 372, 375 (C.C.P.A. 1959); TMEP §1212.01. Thus, applicant must establish that the purchasing public has come to view the proposed mark as an indicator of origin.

**To support the claim of acquired distinctiveness, applicant may respond by submitting additional evidence.** *In re Half Price Books, Records, Magazines, Inc.*, 225 USPQ 219, 220 n.2 (TTAB 1984); TMEP §1212.02(g). Such evidence may include specific dollar sales under the mark, advertising figures, samples of advertising, consumer or dealer statements of recognition of the mark as a source identifier, affidavits, and any other evidence that establishes the distinctiveness of the mark as an indicator of source. See 37 C.F.R. §2.41(a); *In re Ideal Indus., Inc.*, 508 F.2d 1336, 184 USPQ 487 (C.C.P.A. 1975); *In re Instant Transactions Corp.*, 201 USPQ 957 (TTAB 1979); TMEP §§1212.06 *et seq.* The Office will decide each case on its own merits.

If additional evidence is submitted, the following factors are generally considered when determining acquired distinctiveness: (1) length and exclusivity of use of the mark **in the United States** by applicant; (2) the type, expense and amount of advertising of the mark **in the United States**; and (3) applicant's efforts **in the United States** to associate the mark with the source of the goods and/or services, such as unsolicited media coverage and consumer studies. See *In re Steelbuilding.com*, 415 F.3d 1293, 1300, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005). A showing of acquired distinctiveness need not consider all of

these factors, and no single factor is determinative. *In re Steelbuilding.com*, 415 F.3d at 1300, 75 USPQ2d at 1424; *see* TMEP §§1212 *et seq.*

To establish acquired distinctiveness, an applicant may only rely on use in commerce that may be regulated by the United States Congress. *See* 15 U.S.C. §§1052(f), 1127. **Use solely in a foreign country or between two foreign countries is not evidence of acquired distinctiveness in the United States.** *In re Rogers*, 53 USPQ2d 1741, 1746-47 (TTAB 1999); TMEP §§1010, 1212.08.

Applicant cannot overcome the refusal by amending the application to the Supplemental Register. A mark in an application under Trademark Act Section 66(a) is not eligible for registration on the Supplemental Register. 37 C.F.R. §§2.47(c), 2.75(c); TMEP §816.01; *see* 15 U.S.C. §1141h(a)(4).

Accordingly, for the above reasons, the examining attorney again concludes that the applied-for mark is merely descriptive of the identified services, and is unpersuaded by the applicant's arguments to the contrary. Accordingly, the refusal to register under Section 2(e)(1) is hereby maintained and made **FINAL**.

### Applicant's Response

If applicant does not respond within six months of the date of issuance of this final Office action, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this final Office action by:

- (1) Submitting a response that fully satisfies all outstanding requirements, if feasible; and/or
- (2) Filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class.

37 C.F.R. §§2.6(a)(18), 2.64(a); TBMP ch. 1200; TMEP §714.04.

In certain rare circumstances, a petition to the Director may be filed pursuant to 37 C.F.R. §2.63(b)(2) to review a final Office action that is limited to procedural issues. 37 C.F.R. §2.64(a); TMEP §714.04; *see* 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

/Anthony M. Rinker/  
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**TO RESPOND TO THIS LETTER:** Go to [http://www.uspto.gov/trademarks/teas/response\\_forms.jsp](http://www.uspto.gov/trademarks/teas/response_forms.jsp). Please wait 48-72 hours from the issue/ mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov). For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

**All informal e-mail communications relevant to this application will be placed in the official application record.**

**WHO MUST SIGN THE RESPONSE:** It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

**PERIODICALLY CHECK THE STATUS OF THE APPLICATION:** To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov) or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

**TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS:** Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)**

**IMPORTANT NOTICE REGARDING YOUR  
U.S. TRADEMARK APPLICATION**

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED  
ON **9/10/2013** FOR U.S. APPLICATION SERIAL NO. 79106761

Please follow the instructions below:

**(1) TO READ THE LETTER:** Click on this [link](#) or go to <http://tsdr.uspto.gov>, enter the U.S. application serial number, and click on “Documents.”

The Office action may not be immediately viewable, to allow for necessary system updates of the application, but will be available within 24 hours of this e-mail notification.

**(2) TIMELY RESPONSE IS REQUIRED:** Please carefully review the Office action to determine (1) how to respond, and (2) the applicable response time period. Your response deadline will be calculated from **9/10/2013** (*or sooner if specified in the Office action*). For information regarding response time periods, see <http://www.uspto.gov/trademarks/process/status/responsetime.jsp>.

**Do NOT hit “Reply” to this e-mail notification, or otherwise e-mail your response** because the USPTO does NOT accept e-mails as responses to Office actions. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System (TEAS) response form located at

[http://www.uspto.gov/trademarks/teas/response\\_forms.jsp](http://www.uspto.gov/trademarks/teas/response_forms.jsp).

**(3) QUESTIONS:** For questions about the contents of the Office action itself, please contact the assigned trademark examining attorney. For *technical* assistance in accessing or viewing the Office action in the Trademark Status and Document Retrieval (TSDR) system, please e-mail [TSDR@uspto.gov](mailto:TSDR@uspto.gov).

## **WARNING**

**Failure to file the required response by the applicable response deadline will result in the ABANDONMENT of your application.** For more information regarding abandonment, see <http://www.uspto.gov/trademarks/basics/abandon.jsp>.

**PRIVATE COMPANY SOLICITATIONS REGARDING YOUR APPLICATION:** Private companies **not** associated with the USPTO are using information provided in trademark applications to mail or e-mail trademark-related solicitations. These companies often use names that closely resemble the USPTO and their solicitations may look like an official government document. Many solicitations require that you pay “fees.”

Please carefully review all correspondence you receive regarding this application to make sure that you are responding to an official document from the USPTO rather than a private company solicitation. All official USPTO correspondence will be mailed only from the “United States Patent and Trademark Office” in Alexandria, VA; or sent by e-mail from the domain “@uspto.gov.” For more information on how to handle private company solicitations, see [http://www.uspto.gov/trademarks/solicitation\\_warnings.jsp](http://www.uspto.gov/trademarks/solicitation_warnings.jsp).